

REMARKS

Claims 1 and 3-11 are currently pending in this application. Claim 2 has been canceled without prejudice to the subject matter therein.

Claims 1 and 3-11 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Pat. No. 6,287,285 by Michal et al. ("Michal") in view of U.S. Pat. No. 6,153,252 by Hossainy et al. ("Hossainy"), or in view of U.S. Pat. No. 6,306,144 by Sydney et al. ("Sydney"), or in view of U.S. Pat. No. 6,409,716 by Sahatjian et al. ("Sahatjian"), or in view of U.S. Pat. No. 6,348,060 by Brown ("Brown").

Claims 1, 3, 6, 7 and 11 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Michal in view of Hossainy. However, none of the cited references disclose or suggest a "releasable implant releasably positioned in physical communication with the first implant adhesion-resistant treatment on the surface of said releasable implant retention region," as recited in claim 1. Michal regards a therapeutic, diagnostic, or hydrophilic coating for a medical device. In the embodiments described in Michal either the stent or the catheter has a coating, but not both. The Examiner cites Hossainy for disclosing a coated stent. However, similar to Michal, Hossainy is silent as to a delivery system wherein the coating on the stent is in contact with the coating on the catheter. Since the cited references do not teach or suggest all the claim limitations, claim 1 and all claims dependent thereon are patentable over the cited references.

In addition to the previous paragraph, claim 1 is patentable over the cited references because a prima facie case of obviousness has not been established. More specifically, none of the cited references disclose a motivation to combine a coated stent and a coated catheter as recited in claim 1. In order to establish a prima facie case of obviousness, the teaching or suggestion to make the claimed combination, and a reasonable expectation of success, must both be found in the prior art and not in Applicant's disclosure. *See* MPEP § 2412. The Examiner alleges that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the stent of the Michal et al reference to add a plurality of coatings around the stent in order to deliver therapeutic and pharmaceutical agents to a targeted area." However, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *See* MPEP § 2413.01; *Al-site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). Moreover, Michal already discloses a coated stent, so Hossainy adds nothing. Hossainy cannot be a basis simply on its disclosure of a coated stent. Indeed, given that Michal

shows the alternative use of a coated stent or a coated catheter, but nowhere suggests combining the two, teaches away from the pending claims and shows their patentability. For at least the above mentioned reasons, claim 1 and all claims dependent thereon are patentable over the cited references.


Claims 4, 5 and 8 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Michal in view of Hossainy and in further in view of Sydney. However, none of the cited references disclose “two coaxial sleeves positioned in physical communication with the releasable implant retention region,” as recited in claim 4. Additionally, none of the cited references discloses “a conduit in fluid communication with the releasable implant retention region,” as recited in claim 5. Furthermore, Sydney cannot be combined with the other cited references because Sydney teaches away from the current invention. It is improper to combine references where the references teach away from their combination. MPEP § 2145. Sydney discloses an implant delivery system wherein “the surface of the balloon 18 shown contacting stent 17 is best not coated, or coated with a less lubricious coating than the catheter proper, or coated with an adhesive...” See col. 4, lines 20-25. However, the current invention relates to an implant delivery device wherein “the releasable implant releasably positioned in physical communication with the first implant adhesion-resistant treatment on the surface of said releasable implant retention region,” as recited in claim 1. Thus, Sydney cannot be combined with the other cited references for the above stated reasons, and dependent claims 4, 5 and 8 are therefore patentable.

CONCLUSION

Should the Examiner have any questions concerning this application, the Examiner is invited to contact the undersigned at the number given below.

Respectfully submitted,

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